



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/200,853	11/30/1998	YASUHIRO YAMAMOTO	P17029	9849

7590 03/13/2003

GREENBLUM & BERNSTEIN  
1941 ROLAND CLARKE PLACE  
RESTON, VA 20191

EXAMINER

GHEE, ASHANTI

ART UNIT

PAPER NUMBER

2622

DATE MAILED: 03/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/200,853

Applicant(s)

YAMAMOTO, YASUHIRO

Examiner

Ashanti Ghee

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) \_\_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 November 1998 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments with respect to claims 1-12 have been considered but are moot in view of the new ground(s) of rejection.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamaguchi et al. (US Patent Number 5,390,003).

Regarding claim 1, Yamaguchi discloses an image reading device comprising: a housing (Fig. 1); a reading processor that optically reads an image recorded on a recording material sheet to generate an image (column 8, lines 30-column 9, lines 1-46); an image data transmitting processor that can transmit said image data externally to a peripheral device (column 5, lines 45-column 6, lines 1-34); an image data recording processor that can record said image data in a recording medium mounted in said housing (column 8, lines 30-column 9, lines 1-46); a recording operation determination processor that determines, based on a state of said recording medium,

whether a recording operation of said image data recording processor is possible (column 9, lines 49-column 11, lines 1-16); and a control processor that, when said recording operation determination processor determines that said recording operation is impossible, prohibits said recording operation and allows said image data transmitting processor to transmit said image data to said peripheral device (column 9, lines 49-column 11, lines 1-16).

Regarding claim 2, Yamaguchi discloses a device further comprising a display device that indicates said recording operation is prohibited when said recording operation determination processor determines that said recording operation is impossible (column 7, lines 32-49).

Regarding claim 3, Yamaguchi discloses a device wherein said recording operation determination processor determines whether said recording operation is possible based on whether said recording medium is mounted in said housing (column 9, lines 47-column 10, lines 1-4).

Regarding claim 4, Yamaguchi discloses a device wherein said recording operation determination processor determines whether said recording operation is possible based on a remaining recordable volume of said recording medium (column 9, lines 47-column 11, lines 1-16).

Regarding claim 5, Yamaguchi discloses a device wherein said recording operation determination processor determines whether said recording operation is possible based on a formatting state of said recording medium (column 11, lines 17-62).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaguchi et al. (US Patent Number 5,390,003) in view of Moronaga et al. (US Patent Number 5,473,370).

Regarding claim 6, Yamaguchi does not specifically disclose a device wherein said recording operation determination processor determines whether said recording operation is possible based on a type of said recording medium.

However, Moronaga discloses a device wherein said recording operation determination processor determines whether said recording operation is possible based on a type of said recording medium (column 9, lines 36-42).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would combine the teachings of Moronaga and Yamaguchi due to both disclosing an image reading device to greatly simplify the operation for the user.

Regarding claim 7, Yamaguchi does not specifically disclose a device wherein said recording medium comprises a memory card. However, Moronaga discloses a

device wherein said recording medium comprises a memory card (column 24, lines 24-26).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would include the teachings of Moronaga due with the teachings of Yamaguchi due to both disclosing an image reading device to greatly simplify the operation for the user.

Regarding claim 8, Yamaguchi does not disclose a device wherein said memory card comprises a PC card. However, Moronaga discloses a device wherein said memory card comprises a PC card (column 24, lines 24-26).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would include the teachings of Moronaga with the teachings of Yamaguchi due to both disclosing an image reading device to greatly simplify the operation for the user.

6. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaguchi et al. (US Patent Number 5,390,003) in view of Suzuki (US Patent Number 6,347,162).

Regarding claim 9, Yamaguchi does not disclose a device wherein said recording medium comprises a magneto-optical disc. However, Suzuki discloses a device wherein said recording medium comprises a magneto-optical disc (column 7, lines 35-37).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would include the teachings of Suzuki with the

teachings of Yamaguchi due to both disclosing image reading devices to provide prompt and simple operation.

7. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaguchi et al. (US Patent Number 5,390,003) in view of Hirai et al. (US Patent Number 5,315,403).

Regarding claim 10, Yamaguchi does not disclose a device wherein said recording medium comprises a magnetic disk. However, Hirai discloses a device wherein said recording medium comprises a magnetic disk (column 3, lines 26-29).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would include the teachings of Hirai with the teachings of Yamaguchi due to both disclosing an image reading device to provide a storage medium having the high storage speed to transfer image information to a storage medium having a low speed.

10. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaguchi et al. (US Patent Number 5,390,003) in view of Yoshiura et al. (US Patent Number 5,854,693).

Regarding claim 11, Yamaguchi does not specifically disclose a device wherein the peripheral device comprises a computer. However, Yoshiura discloses a device wherein said peripheral device comprises a computer (column 52, lines 3-7).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would include the teachings of Yoshiura with the teachings of Yamaguchi to provide a visible image in a short period of time.

***Claim Rejections - 35 USC § 102***

11. Claim 12 is rejected under 35 U.S.C. 102(b) as being anticipated by Yamaguchi et al. (US Patent Number 5,390,003).

Regarding claim 12, Yamaguchi discloses an image reading device comprising: means for optically reading an image recorded on a recording material sheet to generate image data (column 8, lines 30-column 9, lines 1-46); means for transmitting said image data to a computer provided externally to said image reading device (column 7, lines 30-column 8, lines 1-29); means for determining, based on a state of said recording medium, whether a recording operation of said image data recording processor is possible (column 9, lines 47-column 11, lines 1-16); and means for controlling said transmitting means and said recording means, said control means prohibiting said recording operation and allowing said image data transmitting means to transmit said image data to said computer when said determining means determines that said recording operation is impossible (column 9, lines 47-column 11, lines 1-6).



**Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


**Yamaguchi et al.** (US Patent Number 5,677,775) discloses an image forming apparatus provided with a device for controlling communication with a central supervisory apparatus.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ashanti Ghee whose telephone number is (703) 306-3443. The examiner can normally be reached on Monday-Friday (7AM - 4PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7455 for regular communications and (703) 746-7455 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Ashanti Ghee  
Examiner  
Art Unit 2622

  
EDWARD COLES  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER

Application/Control Number: 09/200,853

Page 9

Art Unit: 2622

ag

March 10, 2003